

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

SEP 17 2003

**U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SCOT YOUNG

Appeal No. 2002-0812
Application No. 09/588,778

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1.
Claims 2 to 8, the only other claims pending in this application, have been allowed.

We REVERSE.

BACKGROUND

The appellant's invention relates to mop buckets and service carts or trolleys for mop buckets (specification, p. 1). Claim 1 under appeal reads as follows:

A detachable trolley and mop bucket combination comprising a mop bucket having wheels thereon and movable over a floor surface and a trolley having a frame adapted for carrying cleaning supplies, the trolley supported by wheels thereon for moving over a floor surface, the trolley and the bucket separately and independently movable and having a connection between them for selective attachment to securely connect the mop bucket to the trolley so that the combined trolley and bucket can be easily maneuvered by one person.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wells	4,319,761	Mar. 16, 1982
Kresse et al. (Kresse)	5,913,528	June 22, 1999

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kresse in view of Wells.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 9, mailed August 7, 2001) and the answer (Paper No. 14, mailed November 5, 2001) for the examiner's complete reasoning in support of the rejection,

and to the brief (Paper No. 13, filed October 15, 2001) and reply brief (Paper No. 15, filed January 11, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claim 1 under appeal. Accordingly, we will not sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The claim under appeal requires a detachable trolley and mop bucket combination comprising, inter alia, (1) a mop bucket having wheels thereon and movable over a floor surface; (2) a trolley having a frame adapted for carrying cleaning supplies, the trolley supported by wheels thereon for moving over a floor surface; and (3) a connection between the trolley and the mop bucket for selectively securing the mop bucket to the trolley so that the combined trolley and bucket can be easily maneuvered by one person.

In the rejection before us in this appeal (final rejection, pp. 2-3), the examiner (1) set forth the teachings of both Kresse and Wells; (2) ascertained¹ that Kresse does not disclose a mop bucket having wheels thereon and movable over a floor surface but instead discloses a trailer; and (3) concluded that

[a]t the time of the invention, it would have been obvious to a person of ordinary skill in this art to substitute a mop bucket for the trailer in Kresse in view of the teachings of Wells. The motivation for doing so would have been to wheel both around as a single unit, thereby greatly reducing the amount of labor involved (See Wells, column 1, lines 20-25).

¹ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The appellant argues that there is no motivation or suggestion in the applied prior art to have substituted a mop bucket for the trailer in Kresse to arrive at the claimed invention. We agree.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness

based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In this case, the examiner's stated reason for modifying Kresse (i.e., to wheel both around as a single unit, thereby greatly reducing the amount of labor involved) does not provide any motivation for a person of ordinary skill in the art to have substituted a mop bucket for the trailer in Kresse. In Kresse, the trolley 1 and coupled trailer 2 are already wheeled around as a single unit. The examiner has not provided any rationale, and our reading of Kresse and Wells does not provide us with any basis, as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have replaced Kresse's trailer with a mop bucket. In our view, the only possible suggestion for modifying Kresse in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1553, 220 USPQ at 312-13.

CONCLUSION

REVERSED

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

² In the answer (p. 5), the examiner appears to state that Kresse's trailer is known to be used for sitting a bucket thereon. However, the examiner did not rely on this general knowledge in the rejection before us in this appeal. Moreover, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). If the examiner is aware of any evidence establishing that at the time the invention was made it was known to use a trailer, such as that disclosed in Kresse, to support a bucket, the examiner should cite that evidence and determine if claim 1 is patentable under 35 U.S.C. § 103 over the combined teachings of Kresse and that evidence.

Appeal No. 2002-0812
Application No. 09/588,778

Page 8

BRUCE DAY
SWANSON MIDGLEY LLC
SUITE 400
2420 PERSHING
KANSAS CITY, MO 64108

JVN/jg